

Remarks

Applicant wishes to thank the Patent Examiner and the Supervisory Patent Examiner for the courtesy extended during the telephone interview of August 26, 2002.

With entry of this amendment, claims 1-8 and 10-33 are pending in this application with claim 1 being the only independent claim. By the foregoing amendments, claims 1 and 32 are sought to be amended and are presented for reconsideration. Claim 33 is added and presented for consideration. These changes are believed not to introduce new matter and their entry is respectfully requested. More specifically, support for the amendment to claim 1 is found in Fig. 5B of the drawings, and support for claim 33 is found on page 7, lines 21-22 of the specification.

1. Rejection under 35 U.S.C. § 112, ¶ 2

Claims 1-8 and 10-32 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is asserted that there is insufficient antecedent basis for the limitation "said top point," which is recited in claim 1.

In response, Applicant has amended claim 1 by deleting the "said top point" limitation. Applicant respectfully submits that the rejection of claims 1-8 and 10-32 under 35 U.S.C. § 112, ¶ 2 thus has been rendered moot. Withdrawal of this rejection is respectfully requested.

2. Rejection under 35 U.S.C. § 102(b)

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by International Application WO91/19856 (*Johansson*). Regarding claim 1, it is asserted that *Johansson* discloses all of the features of claim 1 including the element of "a means for pivotally interconnecting said plurality of speed bump cells." The interconnecting means of *Johansson* is a series of chain links

extending between the end walls of the profile bodies, resulting in each profile body being separated from an adjacent profile body by a space equal to the length of a chain link.

In response, Applicant has amended claim 1 in order to clarify the differences between Applicant's invention and the invention disclosed in *Johansson*. More specifically, Applicant has amended claim 1 by including the limitation "that each of said plurality of speed bump cells abuts a speed bump cell adjacent thereto." As discussed above, this limitation does not constitute new matter as support for the limitation is shown in Fig. 5B of the drawings.

The profile bodies in *Johansson*, *i.e.*, speed bump cells, are interconnected by chain links which are screwed into the end walls with the aid of threaded bolts and nuts. As shown more clearly in Fig. 3 of *Johansson*, the profile bodies do not contact, or abut, one another because there is a gap between adjacent profile bodies. The gap is bridged by the chain links. In contrast, and as more clearly defined in amended claim 1, each speed bump cell of Applicant's invention abuts, or touches, an adjacent speed bump cell. This structural limitation is neither taught, suggested, nor disclosed in *Johansson*. As a result, Applicant respectfully submits that *Johansson* does not anticipate Applicant's invention as claimed in amended claim 1. *See, e.g.*, MPEP §2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the ... claim."); *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990) (the elements must be arranged as required by the claim).

Withdrawal of the §102(b) rejection of claim 1 is therefore respectfully requested.

Regarding claims 2-4, all of these claims depend, either directly or indirectly, from independent claim 1. They all therefore include the claim limitation "that each of said plurality of speed bump cells abuts a speed bump cell adjacent thereto," as included in amended claim 1. As discussed above, *Johansson* does not disclose this claim limitation. Claims 2-4, like independent claim 1, thus are not anticipated by *Johansson*. Withdrawal of the rejection of these claims is respectfully requested.

3. *Rejection under 35 U.S.C. § 103(a)*

Claims 5-8 and 10-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson*, either alone, combined with various other patents, or combined with the knowledge possessed by one of ordinary skill in the art. More specifically, Claims 5-8 and 21-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* combined with the knowledge of the skilled artisan. Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 5,639,179 (*Jensen*). Claims 11-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 5,513,924 (*Alghunaim*). Claims 14, 15, and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 5,703,719 (*Chen*). Claims 16 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view U.S. Patent No. 5,710,558 (*Gibson*). Claims 17 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 5,630,674 (*Inaba*). Claims 18-20, 29, and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 3,798,743 (*Griswold*). Claims 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 6,102,612 (*Pricone*). Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 6,032,684 (*Narron*). Claim 30 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 3,798,743 (*Griswold*), and further in view of *Gibson*. Claim 32 stands rejected under 35 USC §103(a) as being unpatentable over *Johansson* in view of U.S. Patent No. 6,174,103 (*Stroman*).

Regarding claim 1, applicant respectfully asserts that claim 1, as amended, is non-obvious over *Johansson*. As discussed above, the amendment to claim 1 added the limitation "that each of said plurality of speed bump cells abuts a speed bump cell adjacent thereto." This limitation is neither disclosed, taught, or suggested by *Johansson* (or in any of the prior art patents cited by the Examiner). In fact, the interconnection means of *Johansson* teaches away from applicant's invention.

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Johansson discloses the use of chain links to interconnect profile bodies such that each profile body is separated by a gap from an adjacent profile body. According to the specification, this gap is needed to allow the device to "adjust[s] itself to any surface unevenness in the transverse direction of the roadway." *See Johansson*, page 4, lines 4-5. Therefore, the use of chain links is essential to the operation of the *Johansson* device.

In sharp contrast to the *Johansson* device, applicant's device includes the embodiment wherein adjacent speed bump cells are in direct contact with (abut) each other through the use of a locking pin, a universal joint, male/female connectors, or a piano hinge. *See Specification*, page 9, lines 3-9; page 7, lines 21-22; Fig. 5B. This directed contact is desirable to effectively and efficiently "roll up" the speed bump cells of the unit.

Therefore, applicant respectfully submits that claim 1 is not obvious in view of *Johansson* either alone or in combination with the other cited prior patents, because, as discussed above, there is no suggestion or motivation to combine these reference teachings, and the prior art references do not teach all of the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01, *citing In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Recently the Federal Circuit held that "[a]n obvious claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis." *See Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000). The Federal Circuit reversed the district court by requiring that there must be "specific evidence of motivation to combine - conclusory statements are not enough to reach a conclusion of obviousness." The Federal Circuit has also stated that even when the combination of references teaches every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. MPEP §2143.01, *citing In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Therefore, since there is no motivation to teach the abutting of two profile bodies of

Johansson and the fact that *Johansson* teaches away from such contact between adjacent profile bodies, amended claim 1 is non-obvious.

Regarding dependent claims 2-8 and 10-32, it is well established in the patent law "that allowance of a parent or base claim as patentable normally results in allowance of a claim dependent upon that claim." *See DONALD S. CHISUM, CHISUM ON PATENTS* § 7.04[2]; *U.S. v. Electronics, Inc.*, 658 F. Supp. 579, 591, 3 USPQ2d 1571, 1580 (D. Colo. 1987), *aff'd in part and rev'd in part*, 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988), *cert. denied*, 109 S. Ct. 1954 (1989) ("Since it would not have been obvious to have made the invention defined in claim 1, ... it would not have been obvious to make the inventions defined in dependent claims 3, 4 and 5."); *In re Fine*, 837 F.2d 1071, 1076, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.").

As discussed above, Applicant respectfully submits that independent claim 1 is patentably distinguishable and non-obvious over the prior art, and thus is in proper condition for allowance. Since it would not have been obvious to make the invention claimed in amended claim 1, it would not have been obvious to make the inventions defined in dependent claims 5-8 and 10-32, which are narrower than amended independent claim 1. Applicant respectfully submits that claims 5-8 and 10-32, like amended independent claim 1, are in proper condition for allowance. Withdrawal of the rejection of these claims is respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited

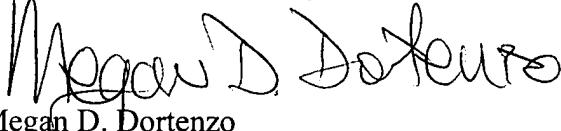


to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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